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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 08/993,699 | 12/18/1997 | DONALD E. HANEY | HAN301F | 5539 |

7590 06/23/2004

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| EXAMINER |
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ROSE, ROBERT A

| ART UNIT | PAPER NUMBER |
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3723

DATE MAILED: 06/23/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

08/993,699

Applicant(s)

HANEY, DONALD E.

Examiner

Robert Rose

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 March 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 16,17,20-26,34 and 36-50 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 34,36,37 and 41 is/are allowed.
- 6) ☒ Claim(s) 16,20-25,38-40 and 42-50 is/are rejected.
- 7) ☒ Claim(s) 17 and 26 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

DETAILED ACTION

1. Claims 1-15, 18-19, 27-33, and 35 have been canceled.
2. Applicant has amended claim 17, but has indicated in his remarks that claim 17 was to be canceled. Examiner has treated amended claim 17 on the merits. However, if it was Applicant's intention to cancel claim 17, he should so direct in the next response to this Office action.
3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.
4. Claims 16 and 21-22 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Linden(Netherlands Patent No. 8802627). Linden discloses all of the subject matter set forth in Applicant's claims above. The platen carries a deformable pad and an abrasive, and is driven in a curvilinear translational orbiting motion superimposed on a twisting motion of the platen(see translation page 3, last paragraph).
5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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6. Claims 20, 23, 25, 38-40, 42-48, and 49-50 are rejected under 35 U.S.C. 103(a) as being unpatentable over Linden. To provide the abrasive in the form of an abrasive sheet to facilitate removal and replacement of the abrasive as a unit when worn, would have been at most an obvious matter of design choice to those of ordinary skill in the art, since it is well known in the abrasive tool art to secure abrasive in the form of sheets to backup platens for this reason. With regard to claim 25, the incorporation of additional such platens into the device of Linden to treat the workpiece in successive steps, would have constituted no more than an obvious duplication of parts.
7. Claims 17, and 26 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.
8. Claims 34, 36-37, and 41 are allowed.
9. Applicant's arguments filed March 18, 2004 have been fully considered but they are not persuasive. The platen of the Linden('627) disclosure carries a deformable pad and an abrasive, and it is clear from the translation of Linden(at page 3, last paragraph) that the platen is driven in a curvilinear translational orbiting motion superimposed on a twisting motion of the platen. This to-and-fro twisting of the support which carries the platen, is about the centerline of the support(24), and is fairly readable as a reciprocal motion. With regard to claim 50, the platen in Linden must necessarily impart this reciprocal motion to the abrasive sheet structure, since it is the only structure in contact therewith. Applicant's amendment to claims 17, and 26, reciting the motions as being superimposed

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orbital motion and circular translational orbital motion, are deemed to define over the art of record.

10. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

11. Any inquiry concerning this communication should be directed to Robert Rose at telephone number (703) 308-1360.

rr

June 21, 2004.



ROBERT A. ROSE
PRIMARY EXAMINER
ART UNIT 323